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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,969	06/15/2001	David T. Berquist	56823US4A.002	9992

32692 7590 04/20/2005

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EXAMINER
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RIMELL, SAMUEL G

ART UNIT	PAPER NUMBER
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2165

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/882,969

**Applicant(s)**

BERQUIST ET AL.

**Examiner**

Sam Rimell

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
- 4a) Of the above claim(s) 45-71 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
**SAM RIMELL**  
**PRIMARY EXAMINER**

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing or drawings under 37 CFR 1.81(c). No new matter may be introduced in the required drawing. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9, 11-36 and 38-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Fitzgerald et al. (U.S. Patent 6,260,049).

Claim 1: FIG. 4 illustrates a paper folder. The paper folder is maintained on shelves in specific locations, as seen in FIGS. 2-3. The collection of folders in their shelving locations constitutes an existing database. Each folder is an item.

In order to manage the folders, the system of Fitzgerald et al. teaches a computer system as seen in FIGS. 7-8 that can obtain information related to the folders and reformat the paper information into digital information that can be stored in an electronic database (126 in FIG. 7). The digital information can be graphically viewed through graphical interfaces, such as FIGS. 9, 11 and 15.

Once the data is in digital form, the paper folders can include RFID tags to replace their bar code tags (FIG. 43 and col. 24, lines 9-29). The RFID tags can be scanned much like the

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original bar code tags on the files, and once scanned, can reference the computer system to provide information associated with the folders.

Claim 2: The existing database is the set of paper folders. The items are individual folders and include item identifiers (file numbers, such as 123-45-67 as seen in FIG. 4).

Claim 3: The paper folder (FIG. 4) can include a bar code (82).

Claim 4: The item identifiers are numbers which are characters.

Claim 5: An example of information exported from the paper folders are shown in FIG. 15. It includes an ordered list of folders, ordered according to folder number.

Claim 6: As seen in FIG. 15, each folder is associated with a specific shelf location ("LOC"), and the list represents an ordered set of folders.

Claim 7: The listing shown in FIG. 11 is a search list, resulting from a search for the movement history of a particular folder, "216785".

Claim 8: FIG. 6 interface 108 illustrates the presence of a CD ROM, which is a removable non-volatile memory disk.

Claim 9: A CD ROM is a solid state device.

Claim 11-12: As seen in FIG. 15, the database of folders includes more than one folder, and each folder constitutes an individual record (an individual row in the display of FIG. 15).

Claim 13: As seen in FIG. 15, a search may be performed to locate specific files. Any files excluded in the search results would be those that do not include the information being requested.

Claim 14: As seen in FIG. 15, each folder is described by a row of information. Each row has a plurality of fields, any one of which can be designated as a primary field or secondary

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field. The fields of data are imported from the paper folders into the digital system as seen in FIG. 15.

Claim 15: In FIG. 15, the folders numbers (far left column) is a single type of information.

Claim 16: FIG. 15 illustrates six different fields for each individual folder. Each folder is recorded in a single row of data that constitutes a record. Accordingly, the record has at least six types of information.

Claim 17: In FIG. 15, each row of data is a record. Each record has six fields. Any one field is just a portion of the record.

Claim 18: In FIG. 15, if the primary field is the folder number (see far left column), the folder number is readable as the folder name, folder identification number or folder call number.

Claim 19: As shown in FIG. 43, and described at col. 4, line 21, an RFID tag on the paper folder can be read to provide the identification of the folder, which corresponds to the primary field of “folder number” in FIG. 15, and which is viewable.

Claim 20: FIG. 11 provides a history of movement for a particular folder (folder 216785). The result is multiple records (rows of data) for the same folder.

Claim 21: In FIG. 15, each folder is represented in the electronic database as one record. Each record is considered one entry.

Claim 22-23: FIG. 11 displays multiple records (rows) for a common primary information field (the folder number 216785).

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Claim 24-25: FIG. 11 displays multiple records for a common folder. The folder storage area (the area where the physical folder is located) can be the same location or different locations.

Claim 26: Database entries for previously entered folders can be viewed in FIGS. 11 or 15.

Claim 27: In FIGS. 11 or 15, the entries of data can include item identifiers, such as folder numbers.

Claim 28: The set of data displayed in FIG. 15 represents a summary of the folders.

Claim 29: The log is a listing of the folders which were exported to the computer system.

Claim 30: Col .13, lines 10-14 describe the response to scanning errors and the signals generated. Even one indication to a user of an error would constitute a logging of that error.

Claim 31: A set of folders is considered a library of materials.

Claim 32: Individual folders are files.

Claim 33: Any form of written information is considered evidence. The folders of Fitzgerald et al. contain written information, particularly, medical information.

Claim 34: A folder is readable as container for paper documents.

Claim 35: The computer system in Fitzgerald et al. is operated by software.

Claim 36: See remarks for claim 1.

Claim 38: As seen in FIG. 43, the RFID reader (692) communicates with the computer work station (88).

Claim 39: A human user uses the work station (88). The work station manages a library of folders.

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Claim 40: The system of FIG. 43 is “self service” in the sense that the folders must be manually scanned and the user must manually enter commands to enter and retrieve electronic information about those folders.

Claim 41-42: In Fitzgerald et al., the folders are illustrated without RFID tags (FIG. 4, with bard code only) and FIG. 43 (with RFID tags 688). The bar coded folders can have RFID tags added to substitute for the bar codes (col. 24, line 4, which says the folder 52 deriving from FIG. 4 can have RFID tags added).

Claim 43: The non-RFID tagged folders use bar code, which correlate to file identification characters.

Claim 44: The non-RFID tagged folders are items. The user can enter information about these items in to the workstation (see FIG. 15).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fitzgerald et al. in view of Official Notice.

Claims 10 and 37: Fitzgerald et al. does positively disclose memory systems (104 and 108 in FIG. 6) and RFID readers (692 in FIG. 43). Claims 10 and 37 only differs from Fitzgerald et al. in the use of flash memory and portable RFID readers. Examiner takes Official Notice that both flash memory and portable RFID readers were well known to the person of ordinary skill in the art at the time of invention. It would have been obvious to one of ordinary skill in the art to

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modify Fitzgerald et al. to include flash memory so as to provide a compact portable memory and to provide portable RFID readers for user convenience in scanning as is well known in the art.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (571) 272-4084.

A handwritten signature in black ink, appearing to read 'Sam Rimell', is positioned above the printed name.

Sam Rimell  
Primary Examiner  
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